

Remarks

The Pending Claims

Claims 1-41 are pending in the application. In the office action, the examiner put these claims into two groupings, with the first grouping including claims 1-38 and being identified as Invention I or Group I, and the second grouping including claims 39-41 and being identified as Invention II or Group II. As best understood by the applicants, it appears that the examiner placed the claims into these two groups based on the notion that the groups represent patentably distinct inventions.

When an Application Properly May Be Required to Be Restricted

As stated in the MPEP:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP §806.04-§806.04(i)) or distinct (MPEP §806.05-§806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

(See MPEP §803, pages 800-3 - 800-4, 8th Edition with February 2003 revisions.)

In this regard, the MPEP further states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02).

(*Id.* at page 800-4.)

The Requirement For Restriction Is Improper

Based on the relevant rules, as cited above, the requirement made in the office action to restrict the pending claims (claims 1-41) is improper for at least the following reasons, and therefore, should be withdrawn. First, the examiner has not made a *prima facie* case that the claims are distinct. (Please note, however, that the applicants are not asserting or suggesting that the groupings identified by the examiner are obvious variants of one another; nor are the applicants traversing the examiner's request for restriction on the grounds that the groupings are not patentably distinct.) Second, a thorough search and examination of the pending claims (claims 1-41) may be made without a serious burden on the examiner.

Lack of *Prima Facie* Case

As required by the MPEP, (see, e.g., MPEP §816) the examiner did, in fact, state the particular reasons which he relied on to conclude that the two groupings were distinct. (See the detailed action, paragraph on lower half of page 2.) However, this purported reasoning does not support an assertion of patentably distinct inventions. Instead, these statements go toward a showing of whether two or more inventions are independent — an issue which properly has not been raised or suggested by the examiner. (It is apparent that the statements are geared toward an analysis of whether two or more claimed inventions are independent, for several reasons. For example, as may be seen in the

paragraph on page 2 of the detailed action, the word “unrelated” is used several times — a word which, by definition, applies to the term “independent”, but not to the term “distinct”, as those terms are defined and used in the MPEP. (See, e.g., MPEP §802.01, including the subheading entitled “DISTINCT”.) Also, the paragraph on page 2 of the detailed action cites MPEP §§806.04 and 808.01, both of which are directed to independent inventions, an item which is not at issue, given the examiner’s assertion of distinct inventions.)

The information presented above by the applicants is sufficient for the examiner to withdraw the restriction requirement. Nonetheless, in the spirit of avoiding ambiguity and facilitating compact prosecution, the applicants have taken time to provide additional reasons below, as to why the requirement for restriction properly should be withdrawn.

The Claimed Inventions are Related

The office action seems to clearly indicate that the examiner’s requirement to restrict is based on a notion of two “distinct” claimed inventions. For example, on page 2 of the detailed action, the examiner stated that “[t]he inventions are distinct, each from the other because of the following reasons:”. In addition, in each of the first three paragraphs on page 3 of the detailed action, the examiner stated that “these inventions are distinct for the reasons given above”.

Nonetheless, given the statements on the second half of page 2 of the detailed action, all of which are directed to the concept of “independent” inventions, the applicants are uncertain as to whether the examiner has advanced an independent-invention argument

— either in lieu of, or in combination with, a distinct-invention argument. Therefore, the applicants have provided the following remarks.

The MPEP states that:

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

(See MPEP §802.01, under the heading “INDEPENDENT”.) In this regard, the MPEP also states:

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(See MPEP §806.04 (emphasis added).)

As may be seen from the MPEP definitions and examples recited above, the claimed groupings identified by the examiner are not independent. For example, unlike the shoe/locomotive-bearing example and the house-painting/well-boring example, all of the pending claims (claims 1-41) are directed to a method of treating a flue gas containing a dust or a pollutant.

No Serious Burden

As recited above, in order for a requirement for restriction to be proper, there also must be a serious burden on the examiner. And, if the search and examination of the pending claims may be made without serious burden, then the examiner must examine the pending claims on the merits — regardless of whether the claims properly may be grouped as two or more independent or distinct inventions.

In the present case, a search and examination of the pending claims (claims 1-41), may be made without serious burden, for several reasons. Given the existence of the highly, efficient EAST computerized database, including the ability to combine topical searching (e.g., class/subclass) with word(s) searching, the examiner may efficiently and effectively perform a thorough search and examination of the pending claims.

The MPEP further states that:

A serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP §808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

(See MPEP §§803 and 808.02 (emphasis added).)

In addressing the serious-burden requirement, the examiner mentioned different classifications, separate status in the art, and non-overlapping searches. However, an appropriate explanation of such items, as required by the rules, has not been provided; and therefore, a *prima facie* showing has not been made. And if, for the sake of argument, one were to assume that a *prima facie* case had been made, the information provided below is sufficient to rebut and overcome such a case.

Separate Classification

In the office action, the examiner noted that the first grouping (claims 1-38) may be classified in class 423, subclass 215.5, and the second grouping (claims 39-41) may be classified in class 423, subclass 210. (See the detailed action, page 2.) The examiner then remarked that these groupings have different classifications. However, this explanation is not sufficient.

For example, the rules require a showing of separate classification, not different classification. The purpose for the separate-classification requirement is that it shows that a given distinct subject has attained recognition in the art as a separate subject for inventive effort. See, e.g., MPEP §808.02. The subclasses cited by the examiner, however, do not show this. Instead, not only are the subclasses within the same class, but subclass 215.5 is a closely-related “one dot” indent (called “Solid component”) of subclass 2.0 (called “Modifying or Removing Component of Normally Gaseous Mixture”).

Separate Status in the Art

Even though two or more subjects are classified together, each subject may be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status. (See MPEP §808.02.) On page 3 of the detailed action, the examiner suggested that a separate status exists because of the two groupings’ “recognized divergent subject matter”. However, this statement does not provide the level of explanation and/or evidence required by the MPEP.

Different Field of Search

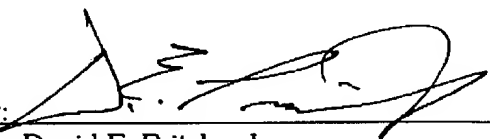
When it is necessary to search for one distinct subject in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two subjects are classified together. (See MPEP §808.02.) With regard to this element, the examiner commented that "the search required for Group I is not required for Group II, and vice versa". (See the detailed action, page 3.) However, that statement is not an appropriate explanation sufficient to satisfy the "different field of search" element.

Conclusion

Given the remarks presented above, the applicants ask the examiner to withdraw the requirement for restriction, and to proceed with a search and examination of the pending claims (claims 1-41). If any issues remain regarding the requirement and/or requested withdrawal, the applicants ask the examiner to call the applicants' representative at the number listed below, thereby facilitating compact prosecution.

Respectfully submitted,

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